

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed December 20, 2005. Claim 21 was objected to. Claims 1,2,4-14, 16-18, and 20-24 were rejected. The claims have been amended to address the concerns raised by the Examiner.

Claims 1-20 were originally presented. Claims 1, 2, 4-14, 16-18, and 20-24 remain in the application. Claims 3, 15, and 19 were canceled by previous amendment. Claims 21-24 were added by previous amendment. By this amendment, claims 1, 2, 4-14, 16-18, and 20-24 have been amended. No new claims have been added. No new subject matter has been added.

Prior to addressing the specific objections and rejections presented in the Office Action, the Applicant would like to present some general comments regarding the amendments. Concerning the specification amendment, the amendment to the priority claim simply inserts the patent number of the patent that issued from the parent application. That patent had not issued prior to the filing of this application.

With respect to the claim amendments, the Applicant has amended all of the pending claims without adding new matter to refer to the apparatus as a “fish net device.” This amendment does not narrow the claims in any way, and is done simply to distinguish the fish net device as a whole from the “net” element of each claim, so as to prevent confusion of the whole with one of its parts.

The Applicant has also amended the independent claims (claims 1, 14 and 18) without adding new matter to specify that the net is of a “flexible net material”, and that the length measuring scale is also flexible. These amendments are supported by the original disclosure, for example at page 7 lines 11-30, which states that suitable net material is flexible, and that the portion including the length measuring scale is made of such material. Additionally, the drawings indicate the flexibility of the length measuring scale by showing it assuming the same contour as the flexible net.

The Applicant has also amended independent claims 1 and 14 without adding new matter to specify that the frame holds the net “in a position to land a fish”. This amendment is

supported by the original specification at least at page 1 lines 22-23, and by the figures, which show a sport fishing net device with a net in position for landing a fish.

The Applicant has also amended claim 12 to further specify that the markings of the length measuring scale are *directly* disposed on the net material. This amendment is supported by the original claims and the original disclosure, which teaches that the length measuring scale is “disposed *on* the fish net 14” (p. 7 ln. 31-32), can be “woven *into* the fabric of the net” (p. 7 ln. 33-34), and can be “applied *to* the surface of the net 14” (p. 8 ln. 13-14) by various weaving, embroidery, or printing methods. Each of the described methods are methods of applying indicia or markings directly on or to the net material. Additionally, the drawings show the measuring scale comprising indicia or markings directly disposed upon the flexible net bag.

The additional amendments to claim 12 do not change its scope, but simply present the various claimed marking types in structural rather than process form (e.g. “woven” markings rather than markings applied by a process of “weaving into the material of the net”).

Claim Objections

Claim 21 was objected to because it does not end in a period. The Applicant has amended claim 21 to correct this typographical error, and respectfully requests that this objection be withdrawn.

Double Patenting

Claims 1-2, 4-14, 16-18, and 20-21 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-3 and 6-18 of U.S. Patent No. 6,615,532 to Abel. The Applicant respectfully submits that the concept of double patenting has no relevance to the present application. The prohibition of double patenting exists to prevent improper extension of the term of patent rights. “Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents.” MPEP § 804 (citing *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982)). The double patenting doctrine does not apply here because there is no possibility of an extension of any patent term. No extension of patent rights is possible in the present case with respect to the ‘532

patent because the present application is a continuation of the application from which the '532 patent issued.

The Applicant wishes to remind the Examiner that, as evidenced by the amended priority claim presented above, and also as shown on the patent application transmittal letter, and as shown on the face of the Filing Receipt, this application is a continuation of United States patent application Ser. No. 10/015,487, filed on 12/11/2001, which is now U.S. Pat. No. 6,615,532. Accordingly, the priority date of this application is identical to that of cited patent, and thus no additional time duration of patent rights could be derived from issuance of a patent upon this application compared to that of the '532 patent because any patent that issues from the present application will automatically have the same termination date.

The Examiner's double patenting rejections amount to citing the present patent application against itself. It is axiomatic that claims arising from a single disclosure may be very similar to each other, but *patentable* distinctness between claims from a common disclosure is not required because the disclosure cannot be prior art to itself. The rule against nonstatutory-type double patenting is "intended to prevent the prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent." MPEP § 804. This presumes that the second patent will have a different priority date from the first – a condition that is not possible between a continuation application and a patent that has issued from its parent.

The Examiner has acknowledged that the claims presented in this application are not identical to the claims in the '532 patent. Accordingly, a patent issuing on this application would present different claims from a common application. This is a very common situation. It is very common for multiple patents to ultimately issue based upon a single parent application, each patent having claims of different scope. This is true of both divisional and continuation applications.

Given that the cited patent and the present application are from a common parent application, the Applicant respectfully submits that the Examiner's double patenting rejections involving the '532 patent are improper, and requests that these rejections be withdrawn.

Claim Rejections - 35 U.S.C. § 102

Claims 1-2, 4-5, 11, 18, 20 and 22-24 (including independent claims 1 and 18) were rejected under 35 U.S.C. § 102(b), as being anticipated by French Patent No. 2582190 to Chat (the “French patent”). The Applicant respectfully submits that the French patent reference does not disclose all of the elements of Applicant’s claims as currently presented.

Before responding to the rejections of specific claims, the Applicant wishes to clarify an aspect of the claims about which there may be some confusion. The Applicant believes the Examiner is comparing non-analogous portions of prior art devices as a whole with the “net” element of Applicant’s claims. As noted above, the Applicant has amended all of the claims to refer to the apparatus as a “fish net device.” This amendment does not narrow the claims in any way, but merely distinguishes the fish net device as a whole from the “net” element of each claim. In other words, as clearly set out in the specification and the claims, the Applicant’s net device as a whole includes the distinct elements of (1) a frame and (2) a net, the “net” being only one element of the “net device” as a whole.

The structure and content of the claims viewed as a whole also confirms this. For example, dependent claims 2, 4-5, 7-12 and 16 all add features to the net element and the length measuring scale. On the other hand, claims 6, 13 and 14 provide additional features of the frame. Claim 6 specifies that the frame includes a hoop shaped portion, and claims 13 and 14 specify that the frame includes both a handle and a hoop portion, both of these portions being clearly shown and described in the specification. Clearly, then, the handle and hoop elements are part of the frame, not part of the net, and the features of the frame portions of prior art therefore cannot be compared to features of the flexible net of the Applicant’s claims. The net is distinct from the frame, and corresponding portions of prior devices cannot be interchanged in the way the Examiner has done.

The Applicant believes the Examiner is comparing apples to oranges when viewing the French patent reference. For example, the French patent includes a net G and measuring scales C and D. However, the measuring scales C, D are not disposed on the net G, but instead are disposed on a rigid gutter or trough that is attached to the net (for which there is no corresponding element in the Applicant’s claims). This gutter is not flexible, and is not part of

the net. It is a separate element with different characteristics, and therefore does not correspond to nor anticipate the Applicant's net element.

Additionally, contrary to the Examiner's assertion, the French patent does not disclose a frame of any kind. The English language abstract of the French patent that has been provided does not mention a frame, and the single illustration does not show one. The Examiner has pointed to no portion of the French patent that shows or mentions a frame. Consequently, the Examiner has no basis for the naked assertion that the French patent teaches or suggests a frame. Accordingly, all of the Examiner's rejections of the Applicant's independent claims under 35 U.S.C. § 102(b) based upon FR Patent No. 2582190 to Chat should be withdrawn as being based upon an improper comparison of non-analogous elements, and the recitation of elements that simply are not present in the cited art.

Turning to specific claims other than the independent claims, with respect to claim 4, modified units of length are not apparent from the figure of the French patent. The cited scales C and D in the figure appear to be of uniform spacing. The Applicant can find no basis for the Examiner's assertion that the French patent teaches modified units of length, and the Examiner has not pointed to any. Additionally, the Examiner has pointed to no portion of the French patent relating to compensation for curvature of a fish. Indeed, since the gutter of the French patent reference is straight in the direction of the measuring scales, there would presumably be no curvature of a fish held in the gutter with respect to those scales.

With respect to claim 5, there is no disclosure in the French patent of a net forming a pocket. The net G in the figure appears to be entirely flat and planar. Again, the gutter is not a net, and cannot be compared to the net element of the Applicant's claims.

With respect to claim 20, the French patent reference does not disclose causing a fish to rest in the bottom of a net. Instead, the reference discloses placing a fish in a trough or gutter. Again, the gutter is not a net.

With respect to claims 22 and 23, contrary to the Examiner's assertion, the French patent does not disclose a length measuring scale that is visible on both sides of a net. Viewing the figure of the French patent, the length markings on the gutter are only shown along one side of

the gutter, and therefore would not be visible to a user viewing from the opposite side of the net (even assuming that the net is substantially see-through, which has not been established).

With respect to claim 24, the Applicant can find no justification for the Examiner's assertion that the French patent discloses English and metric units. There is no mention in the abstract or indication on the drawing related to units of any kind – English, metric, or other. There are numerals, but numerals are not units because there is no indication of what the numeral represent. There is simply no basis for the Examiner's statement.

For all of the above reasons, the Applicant respectfully submits that the French patent reference does not teach or suggest each and every element of claims 1-2, 4-5, 11, 18, 20 and 22-24 as amended. The Applicant thus requests that these rejections be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 6-7, 10 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the French patent in view of Bryant. First, the Applicant respectfully submits that claims 6-7, 10 and 13 should be allowed as being based upon an allowable base claim for the same reasons given above with respect to claim 1.

Additionally, as with the French patent reference discussed above, the Applicant believes the Examiner is comparing non-analogous portions of prior devices as a whole with the “net” element of Applicant's claims. As noted above, the French patent reference does not disclose a length measuring scale that is part of a flexible net. Instead, the French patent discloses length markings disposed on a rigid gutter or trough, which is a separate element from the net. Bryant does not supply this deficiency. Bryant teaches a fish net device with a scale that is part of the net device as a whole, but not as part of the net element itself. The Bryant net device 20 includes a net 28 and a frame comprising a handle 22 and hoop 24. While the device includes a measuring scale 100, this scale is not part of the flexible net element 28, but instead is part of the rigid handle 22. A handle is not a net.

There is no teaching or suggestion in Bryant or the French patent that would lead one of skill in the art to attach a flexible measuring scale to a flexible net attached to the hoop portion of

a frame. Accordingly, the Applicant submits that the claims would not be obvious in view of the cited art.

Considering some of the Examiner's rejections one-by-one, the statements regarding claim 6 are completely without basis. The French patent does not teach a length measuring scale extending from one side of a net to the other first because the measuring scale of the French patent is not on the net at all, but is on a trough, and second because the ends of the net in the French patent are not shown. The extent of the net G in the figure of the French patent is entirely indefinite – it is simply not shown. Thus there is no basis for any assertions about anything extending from one side to another of the net.

With respect to claim 7, the Applicant is unable to follow the Examiner's purported identification of elements. The net 28 of Bryant is shown as a single piece of netting, and the "linear center piece – at 22" that the Examiner has identified is part of the handle of the net device, not part of the net. A frame is not a net. There is no teaching or suggestion in Bryant of a flexible net comprising two side pieces and a center piece that are attached together to form a closed bag.

The Examiner has also rejected claims 14, 16-17 and 21 under 35 U.S.C. § 103(a) as being unpatentable over the French patent in view of Bryant. The Applicant respectfully submits that independent claim 14 should be allowed for the same reasons given above with respect to claim 1 in view of the French patent reference, and claims 16-17 and 21 should be allowed as being based upon an allowable base claim. Specifically, the French patent reference does not disclose a fish net device including a frame and a flexible net, with a flexible length measuring scale disposed on the net, and the Bryant reference does not supply these deficiencies.

Additionally, the Examiner has provided no basis for asserting that the French patent teaches or suggests modified units of length for compensating for curvature of a fish and the length measuring scale (the length measuring scale in the French patent does not curve!), or of a net forming a pocket. None of these elements are shown or mentioned in the translated portions of the French patent. The Examiner's other assertions with respect to these claims are likewise faulty for the reasons given above.

The Examiner has also rejected claims 8-9 under 35 U.S.C. § 103(a) as being unpatentable over the French patent in view of Bryant and further in view of Hungerford. The above remarks with respect to the French patent and Bryant references are fully applicable here, and claims 8 and 9 should be allowed as being based upon an allowable base claim for the reasons given above with respect to claims 7 and 1.

Additionally, like Bryant, Hungerford discloses a net device that includes a net 5 and a frame comprising a handle 1 and a bail or hoop portion 6. While the device as a whole includes a measuring scale, this scale is not part of the net element 5, but instead is part of the handle 1. Like Bryant and the French patent, the Examiner has pointed to no teaching or suggestion in Hungerford to place a flexible measuring scale on the flexible net portion of the net device.

Moreover, Hungerford does not include any teaching or suggestion that the net element 5 comprises a center piece and two side pieces. Indeed, the drawings and specification of Hungerford all refer to the net 5 in terms of a single unitary element, not as an element composed of a center piece and two side pieces attached together.

The Examiner has also rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over the French patent in view of the Caddis catalog reference (“Caddis”). The above remarks with respect to the French patent are fully applicable here, and claim 12 should be allowed as being based upon an allowable base claim for the reasons given above with respect to claim 1. Specifically, the French patent reference does not disclose a fish net device including a frame and a flexible net, with a flexible length measuring scale disposed on the net material, and the Caddis reference does not supply these deficiencies.

Additionally, the Applicant respectfully submits that the Caddis reference is non-analogous prior art. The Caddis reference shows what appears to be a length measuring scale as part of a “stripping apron” on a float tube used by fly fishermen. A stripping apron is for the purpose of holding a fly fisherman’s line out of the water when fishing, and cannot be used for landing a fish, as is a fish net device. Consequently, there would be no motivation for one skilled in the art to combine features of the stripping apron of Caddis with the fish gutter of the French patent.

Moreover, the supposed combination would be non-functional. The combination of Caddis with the French patent would either put length markings on the net G of the French patent, or would attach a rigid gutter to the stripping apron of Caddis. The first option would be of no value because the net of the French patent is flat and planar, and thus there would be no way to hold a fish. The second option would place an obstruction on the stripping apron and prevent its use as a stripping apron. Additionally, the gutter would be sideways, and would not hold a fish.

Furthermore, neither the French patent nor the Caddis reference disclose a fish net device comprising a frame that holds a net “in a position to land a fish” as claimed by the Applicant, with a flexible length measuring scale disposed on the net. For these reasons, the Applicant submits that the rejections based upon Caddis and the French patent should be withdrawn.

Accordingly, the Applicant respectfully submits that independent claims 1, 14 and 18 as now presented are in condition for allowance over the cited art, and that dependent claims 2, 4-13, 16-17, and 20-24 are allowable as being dependent upon an allowable base claim. Therefore, the Applicant respectfully urges the Examiner to withdraw the rejections and allow all claims as now presented.

Secondary Considerations

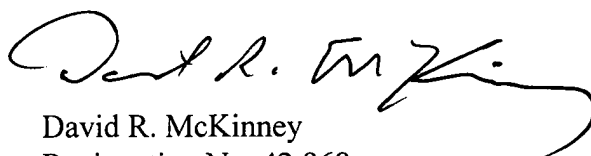
As an additional indication to support the allowability of the claims as currently presented, the Applicant encloses herewith an affidavit signed by the inventor attesting to the commercial success of the invention that is the subject of this patent application. The inventor has been manufacturing and commercially selling sport fishing nets including a measuring scale as disclosed in the present application in ever-increasing numbers for the past several years. The Applicant respectfully submits that the public acceptance and commercial success of these products attests to their novelty and non-obviousness. Accordingly, the Applicant requests that the Examiner withdraw the rejections and objections, and allow this patent to issue.

CONCLUSION

In light of the above, the Applicant respectfully requests that the objections and rejections be withdrawn, and that the Examiner allow all claims as now presented. If there are any matters related to this Response that can be resolved by telephone, the Examiner is strongly encouraged to call the undersigned at (801) 746-8500 so that such matters may be resolved as expeditiously as possible.

DATED this 20 day of April, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David R. McKinney", with a stylized flourish at the end.

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